

Remarks

Claims 1, 3-8, 10-13 and 16-31 are pending in the application. Claim 2 has been canceled. Claims 16-31 are newly added.

Claims 11-13 were rejected under 35 USC 112, first paragraph, as not being enabled by the specification. The Applicant respectfully traverses. "As a general rule, where software constitutes part of a best mode of carrying out an invention, description of such a best mode is satisfied by a disclosure of the functions of the software. This is because, normally, writing code for such software is within the skill of the art, not requiring undue experimentation, once its functions have been disclosed . . . [F]low charts or source code listings are not a requirement for adequately disclosing the functions of software." " MPEP section 2106.1, citing *Fonar Corp.*, 107 F.3d at 1549. In the present specification, the functions of the software have been clearly disclosed; in fact, the Office Action states as much, observing that the specification is "enabling for performing the method steps" (Office Action, par. 1).

It is further noted that "[t]o establish a reasonable basis for questioning the adequacy of a disclosure, the examiner must present a factual analysis of a disclosure to show that a person skilled in the art would not be able to make and use the claimed invention without resorting to undue experimentation." MPEP section 2106.02. The Applicant respectfully submits that the Office Action does not establish such a reasonable basis. The Office Action states that "[t]he specification does not disclose a detailed program software flow chart or psuedo [sic] computer language chart or a program written by an ordinary skilled programmer with reasonable experimentation [sic]." However, the above cite from *Fonar Corp.*, endorsed, in effect, by the Patent Office by its inclusion in the MPEP, states unequivocally that such things are not required for enablement under section 112, first paragraph. Therefore, the Examiner's stated basis for rejection seems to be at odds with the Examiner's own primary source of authority, the MPEP.

The present specification discloses a computer (CPU 281) programmed with software to execute functionality (page 9, lines 18-19) according to the present invention. The functionality is further represented, for example, by a flowchart in

FIG. 5. Data structures associated with executing the functionality are also disclosed, such as the example of information in a device capabilities database as shown in FIG. 3, and related description, and the example of information in an eligibility database as shown in FIGs. 4A and 4A, and related description. Database access operations via a local area network, for example, in connection with these databases are also disclosed (page 9, line 20; page 10, line 25). In view of the foregoing, the Applicant respectfully submits that claims 11-13 are fully enabled, and requests withdrawal of the rejection of claims 11-13 under 35 USC 112, first paragraph.

Claims 1, 6, 8 and 10-13 were rejected under 35 USC 102(e) as being anticipated by Sonti et al. (Sonti) (US 6,108,540).

To anticipate a claim under § 102, a single prior art reference must identically disclose each and every claim element. In view of this, the Applicant respectfully submits that the cited reference fails to support the asserted rejection.

Sonti relates to a method purported to allow subscribers of a telecommunications network to change easily between sets of desired features. Accordingly, Sonti discloses that a subscriber may have a plurality of profiles, with a feature list that varies from profile to profile, maintained at a home location register (col. 5, lines 40-44). There appears to be an "active profile number" which selects which profile and corresponding feature list a subscriber wants to use at a given time. A subscriber may dial in a new profile number to select a new feature list and have it made active at a mobile switching center (col. 8, lines 25-28 and 64-67).

Therefore, Sonti does not anticipate the present invention as claimed in independent claims 1, 6, 11 and 12 for at least the reason that Sonti does not disclose receiving a request for a service to be provided to a mobile communication device, where a device identifier or attribute of the mobile communication device is correlated with information concerning what services the mobile communication device has a technical capability to access, and determining, based on the device identifier or attribute and the corresponding information, whether the mobile communication device is capable of receiving the requested service, as required by claims 1, 6, 11 and 12. In Sonti, there is no determination whether a device is

capable of receiving a requested service. Rather, in view of the above discussion of Sonti, a subscriber is merely enabled to switch between features for which the subscriber is already registered, based on a mapping of feature groups to different subscriber profiles.

Similarly, Sonti does not anticipate the invention as recited in independent claims 10 and 13 for at least the reason that Sonti does not disclose applying a device identifier to an equipment capabilities filter, the equipment capabilities filter comprising information concerning what services the device has a technical capability to access, as required by claims 10 and 13. Again, Sonti is not concerned with determining equipment capabilities, but only with switching between pre-established feature profiles.

In view of the foregoing, the Applicant respectfully requests withdrawal of the rejection of claims 1, 6, 8 and 10-13 under 35 USC 102(e) as being anticipated by Sonti.

Claim 3 was rejected under 35 USC 103(a) as being unpatentable over Sonti in view of Saunders et al. (Saunders) (US 5,918,172). Claims 4 and 7 were rejected under 35 USC 103(a) as being unpatentable over Sonti in view of Fehnel (WO 97/34438). Claim 5 was rejected under 35 USC 103(a) as being unpatentable over Sonti in view of Fehnel and Saunders. To establish a prima facie case of obviousness under Section 103, all claim limitations of a claimed invention must be taught or suggested by the prior art. In view of this, the Applicant respectfully submits that the cited references fail to support the asserted rejection.

Claims 3, 4 and 5 incorporate the limitations of claim 1 by dependency, and claim 7 incorporates the limitations of claim 6 by dependency. Accordingly, claims 3, 4, 5 and 7 are allowable over Sonti for at least the reasons discussed above in connection with claims 1 and 6. Moreover, Saunders and Fehnel do not remedy the deficiencies in Sonti with respect to independent claims 1 and 6. For example, neither Saunders nor Fehnel teaches or suggests receiving a request for a service to be provided to a mobile communication device, where a device identifier or attribute of the mobile communication device is correlated with information concerning what services the mobile communication device has a technical capability to access, and

determining, based on the device identifier or attribute and the corresponding information, whether the mobile communication device is capable of receiving the requested service, as required by claims 1 and 6. Therefore, even in combination with Sonti, Saunders and Fehnel cannot render claims 3, 4, 5 and 7 unpatentable. Withdrawal of the rejection of claims 3, 4, 5 and 7 under 35 USC 103(a) is therefore respectfully requested.

New claims 16 - 31:

The Office Action indicates that claim 2 is allowable if rewritten in independent form. Accordingly, new claim 16 recites claim 2 in independent form. New claims 17, 18 and 19 correspond to claims 3, 4 and 5, respectively, but are dependent on new claim 16. Accordingly, new claims 16-19 are allowable.

New claim 20 corresponds to claim 6, but with the limitations of claim 2 incorporated therein. Because claim 6 includes substantially the same limitations as claim 1, it has also been placed in allowable form by including the limitations of claim 2. New claims 21 and 22 correspond to claim 7 and 8, respectively, but are dependent on claim 20. Accordingly, new claims 20-22 are allowable.

New independent claims 23 and 27 relate to a method and system, respectively, for registering a subscriber as a receiver of a special billing rate for wireless services from a wireless services provider, comprising receiving a request for the special billing rate from the subscriber, and determining whether a wireless communication device associated with the subscriber has a technical capability to be used in a way that the special billing rate is appropriate for the subscriber. The method and system further relate to determining whether the subscriber is eligible for receiving the special billing rate, based at least in part on whether a home location of the subscriber is within a footprint of the wireless services provider; and if a result of the determinations is in the affirmative, registering the subscriber as a receiver of the special billing rate, where the special billing rate is such that all calls either made by or received by the subscriber are billed at the same rate whether or not the wireless communication device is within the wireless services provider's footprint or outside the wireless services provider's footprint. None of the prior art cited in either the

present Office Action or earlier Actions discloses or suggests the foregoing features. Accordingly, new independent claims 23 and 27, and associated dependent claims, are allowable over the art of record.


Conclusion

In light of the above discussion, the Applicant respectfully submits that the present application is in all aspects in allowable condition, and earnestly solicits favorable reconsideration and early issuance of a Notice of Allowance.

The Examiner is invited to contact the undersigned at (202) 220-4323 to discuss any matter concerning this application. The Office is authorized to charge any fees under 37 C.F.R. 1.16 or 1.17 related to this communication to Deposit Account No. 11-0600.

Respectfully submitted,

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